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10/795,836	03/08/2004	Hwei-Ling Yau	87082CPK	1251

7590 07/17/2009  
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EXAMINER
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SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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07/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/795,836	<b>Applicant(s)</b> YAU ET AL.	
	<b>Examiner</b> Betelhem Shewareged	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-9,11,13,15-24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9,11,13 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. Applicant's response along with the Declaration Under Rule 37 CFR 1.131 filed on 07/07/2009 has been fully considered. Claims 2, 4, 10, 12, 14 and 25 are canceled, and claims 1, 3, 5-9, 11, 13, 15-24, 26 and 27 are pending. Currently, claims 26 and 27 are withdrawn from consideration as non-elected invention.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

4. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3, 5-9 and 18-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S.

Patent No. 6,869,178 B2 in view of Landry-Coltrain et al. (2003/0138608 A1).

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6. Combination of current claims 1, 3, 5, 8, 13 and 22 corresponds to claim 1 of '178 in view of Landry-Coltrain, where an ink jet recording medium comprising a support and an image receiving layer as recited in the current claims. '178 further teaches the presence of a base layer over the support (col. 7, lines 45-48), but '178 does not teach the base layer as recited in the claims. However, Landry-Coltrain teaches an ink jet recording element comprising a support and at least two ink receiving layers (abstract and [0070]), wherein the recording element further comprises a base layer having a highly swellable polymers such as gelatin [0068]. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of Landry-Coltrain with the invention of '178, and the motivation would be to absorb the solvent from the ink ([0068] of Landry-Coltrain). Furthermore, current claims 6, 7, 9, 18, 19, and 20 correspond to claims 2-7 of '178, respectively.

7. Claims 1, 3, 5-9, 11, 13 and 15-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,869,178 B2 in view of Tang et al. (US 6,632,485 B1).

8. Combination of current claims 1, 3, 5, 8, 11, 13, 15-17 and 22-24 corresponds to claim 1 of '178 in view of Tang, where an ink jet recording medium comprising a support and an image receiving layer as recited in the current claims. '178 further teaches the presence of a base layer over the support (col. 7, lines 45-48), but '178 does not teach the base layer as recited in the claims. However, Tang teaches an ink jet receiving medium comprising a base layer and a top layer, wherein the base layer comprises a

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crosslinked gelatin and a polyurethane dispersion (Table 5), and the thickness of the base layer is 10um (col. 8, line 61). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of the Tang with the invention of '178, and the motivation would be to reduce the curl and to absorb the majority of the ink (col. 6, line 5 of Tang). Furthermore, current claims 6, 7, 9, 18, 19, and 20 correspond to claims 2-7 of '178, respectively.

9. Claims 1, 3, 5-9 and 18-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S.

Patent No. 6,861,114 B2 in view of Landry-Coltrain et al. (2003/0138608 A1).

10. Combination of current claims 1, 3, 5, 8, 13 and 22 corresponds to claim 1 of '114 in view of Landry-Coltrain, where an ink jet recording medium comprising a support and an image receiving layer as recited in the current claims. '114 further teaches the presence of a base layer over the support (col. 7, lines 45-48), but '114 does not teach the base layer as recited in the claims. However, Landry-Coltrain teaches an ink jet recording element comprising a support and at least two ink receiving layers (abstract and [0070]), wherein the recording element further comprises a base layer having a highly swellable polymers such as gelatin [0068]. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of Landry-Coltrain with the invention of '114, and the motivation would be to absorb the

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solvent from the ink ([0068] of Landry-Coltrain). Furthermore, current claims 6, 7, 9, 18, 19, and 20 correspond to claims 2-7 of '114, respectively.

11. Claims 1, 3, 5-9, 11, 13 and 15-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S.

Patent No. 6,861,114 B2 in view of Tang et al. (US 6,632,485 B1).

12. Combination of current claims 1, 3, 5, 8, 11, 13, 15-17 and 22-24 corresponds to claim 1 of '114 in view of Tang, where an ink jet recording medium comprising a support and an image receiving layer as recited in the current claims. '114 further teaches the presence of a base layer over the support (col. 7, lines 45-48), but '114 does not teach the base layer as recited in the claims. However, Tang teaches an ink jet receiving medium comprising a base layer and a top layer, wherein the base layer comprises a crosslinked gelatin and a polyurethane dispersion (Table 5), and the thickness of the base layer is 10um (col. 8, line 61). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of the Tang with the invention of '114, and the motivation would be to reduce the curl and to absorb the majority of the ink (col. 6, line 5 of Tang). Furthermore, current claims 6, 7, 9, 18, 19, and 20 correspond to claims 2-7 of '178, respectively.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 3, 5-9, 13 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. (US 2004/0090512 A1) in view of Landry-Coltrain et al. (US 2003/0138608 A1).

15. Yau '512 teaches an ink jet recording element comprising a support having thereon a fusible, porous, image-receiving layer comprising at least two types of hydrophobic polymer particles having different glass transition temperatures, the first type of hydrophobic polymer particles having a T<sub>g</sub> higher than about 60 degree C that is substantially monodisperse and the second type of hydrophobic polymer particles having a T<sub>g</sub> lower than about 25 degree C. [see claim 1]. The first type of hydrophobic polymer particles which is substantially monodisperse has an average particle size of from about 0.2 $\mu$ m to about 2 $\mu$ m, and has a particle size distribution such that the ratio of the particle size at the 90<sup>th</sup> percentile of the particle size distribution curve to the particle size at the 10<sup>th</sup> percentile of the particle size distribution curve is less than about 2 [see claims 2]. The first type of hydrophobic polymer particles which is substantially monodisperse has a T<sub>g</sub> of from about 60 degree C to about 140 degree C; and the second type of hydrophobic polymer particles has a T<sub>g</sub> of from about -60 degree C to about 25 degree C [see claims 3 and 4]. The weight ratio of the first type of hydrophobic polymer particles to the second type of hydrophobic polymer particles is from about 10:1 to about 2.5:1; and the image-receiving layer is coated in an amount of from about 10 gsm to about 60 gsm [claims 5 and 6]. The support is resin-coated paper

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or a transparent polymer film; and the image-receiving layer is cross-linked [see claims 7 and 8]. The image receiving layer contains a UV absorbing agent; and the pore volume of the image receiving layer is from 5-50ml/m<sup>2</sup> [see claims 9 and 10]. Yau '512 further teaches the presence of a base layer over the support [0039], but Yau '512 does not teach the base layer as recited in the claims.

16. However, Landry-Coltrain teaches an ink jet recording element comprising a support and at least two ink receiving layers (abstract and [0070]). The recording element further comprises a base layer having a highly swellable polymers such as gelatin [0068]. With respect to the swelling amount, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Landry-Coltrain reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article functions in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Yau '512 and Landry-Coltrain are analogous art because they are from the same field of endeavor that is the ink jet recording art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of Landry-Coltrain with the invention of Yau '512, and the motivation would be to absorb the solvent from the ink ([0068] of Landry-Coltrain).



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17. Claims 1, 3, 5-9, 11, 13 and 15-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. (US 2004/0090512 A1) in view of Tang et al. (US 6,632,485 B1).

18. Yau '512 teaches an ink jet recording element comprising a support having thereon a fusible, porous, image-receiving layer comprising at least two types of hydrophobic polymer particles having different glass transition temperatures, the first type of hydrophobic polymer particles having a Tg higher than about 60 degree C that is substantially monodisperse and the second type of hydrophobic polymer particles having a Tg lower than about 25 degree C. [see claim 1]. The first type of hydrophobic polymer particles which is substantially monodisperse has an average particle size of from about 0.2um to about 2um, and has a particle size distribution such that the ratio of the particle size at the 90<sup>th</sup> percentile of the particle size distribution curve to the particle size at the 10<sup>th</sup> percentile of the particle size distribution curve is less than about 2 [see claims 2]. The first type of hydrophobic polymer particles which is substantially monodisperse has a Tg of from about 60 degree C to about 140 degree C; and the second type of hydrophobic polymer particles has a Tg of from about -60 degree C to about 25 degree C [see claims 3 and 4]. The weight ratio of the first type of hydrophobic polymer particles to the second type of hydrophobic polymer particles is from about 10:1 to about 2.5:1; and the image-receiving layer is coated in an amount of from about 10 gsm to about 60 gsm [claims 5 and 6]. The support is resin-coated paper or a transparent polymer film; and the image-receiving layer is cross-linked [see claims 7 and 8]. The image receiving layer contains a UV absorbing agent; and the pore

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volume of the image receiving layer is from 5-50ml/m<sup>2</sup> [see claims 9 and 10]. Yau '512 further teaches the presence of a base layer over the support [0039], but Yau '512 does not teach the base layer as recited in the claims.

19. However, Tang teaches an ink jet receiving medium comprising a base layer and a top layer, wherein the base layer comprises a crosslinked gelatin and a polyurethane dispersion (Table 5). The thickness of the base layer is 10um (col. 8, line 61). With respect to the swelling amount, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Tang reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article functions in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. With respect to the glass transition (Tg) value of the polyurethane dispersion, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the Tg value in order to improve the flexibility of the layer (col. 4, line 47). A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215. To date, this burden has not been sustained. Furthermore, with respect to the particle size of the polyurethane dispersion, one of

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ordinary skill in the art would have been motivated to adjust the particle size in order to optimize coating durability and absorption property of the layer. Yau '512 and Tang are analogous art because they are from the same field of endeavor that is the ink jet recording medium art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of the Tang with the invention of Yau '512, and the motivation would be to reduce the curl and to absorb the majority of the ink (col. 6, line 5 of Tang).

20. Claims 1, 3, 5-9, 13 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. (US 2004/0090514 A1) in view of Landry-Coltrain et al. (US 2003/0138608 A1).

21. Yau '514 teaches an ink jet recording element comprising a support having thereon a fusible, porous, image-receiving layer comprising at least two types of hydrophobic polymer particles having different glass transition temperatures, the first type of hydrophobic polymer particles having a T<sub>g</sub> higher than about 60 degree C that is substantially monodisperse and the second type of hydrophobic polymer particles having a T<sub>g</sub> lower than about 25 degree C. [see claim 1]. The first type of hydrophobic polymer particles which is substantially monodisperse has an average particle size of from about 0.2 $\mu$ m to about 2 $\mu$ m, and has a particle size distribution such that the ratio of the particle size at the 90<sup>th</sup> percentile of the particle size distribution curve to the particle size at the 10<sup>th</sup> percentile of the particle size distribution curve is less than about 2 [see claims 2]. The first type of hydrophobic polymer particles which is substantially

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monodisperse has a Tg of from about 60 degree C to about 140 degree C; and the second type of hydrophobic polymer particles has a Tg of from about -60 degree C to about 25 degree C [see claims 3 and 4]. The weight ratio of the first type of hydrophobic polymer particles to the second type of hydrophobic polymer particles is from about 10:1 to about 2.5:1; and the image-receiving layer is coated in an amount of from about 10 gsm to about 60 gsm [claims 5 and 6]. The support is resin-coated paper or a transparent polymer film; and the image-receiving layer is cross-linked [see claims 7 and 8]. The image receiving layer contains a UV absorbing agent; and the pore volume of the image receiving layer is from 5-50ml/m<sup>2</sup> [see claims 9 and 10]. Yau '514 further teaches the presence of a base layer over the support [0035], but Yau '514 does not teach the base layer as recited in the claims.

22. However, Landry-Coltrain teaches an ink jet recording element comprising a support and at least two ink receiving layers (abstract and [0070]). The recording element further comprises a base layer having a highly swellable polymers such as gelatin [0068]. With respect to the swelling amount, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Landry-Coltrain reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article functions in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Yau '514 and Landry-Coltrain are

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analogous art because they are from the same field of endeavor that is the ink jet recording art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of Landry-Coltrain with the invention of Yau '514, and the motivation would be to absorb the solvent from the ink ([0068] of Landry-Coltrain).

23. Claims 1, 3, 5-9, 11, 13 and 15-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. (US 2004/0090514 A1) in view of Tang et al. (US 6,632,485 B1).

24. Yau '512 teaches an ink jet recording element comprising a support having thereon a fusible, porous, image-receiving layer comprising at least two types of hydrophobic polymer particles having different glass transition temperatures, the first type of hydrophobic polymer particles having a T<sub>g</sub> higher than about 60 degree C that is substantially monodisperse and the second type of hydrophobic polymer particles having a T<sub>g</sub> lower than about 25 degree C. [see claim 1]. The first type of hydrophobic polymer particles which is substantially monodisperse has an average particle size of from about 0.2um to about 2um, and has a particle size distribution such that the ratio of the particle size at the 90<sup>th</sup> percentile of the particle size distribution curve to the particle size at the 10<sup>th</sup> percentile of the particle size distribution curve is less than about 2 [see claims 2]. The first type of hydrophobic polymer particles which is substantially monodisperse has a T<sub>g</sub> of from about 60 degree C to about 140 degree C; and the second type of hydrophobic polymer particles has a T<sub>g</sub> of from about -60 degree C to

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about 25 degree C [see claims 3 and 4]. The weight ratio of the first type of hydrophobic polymer particles to the second type of hydrophobic polymer particles is from about 10:1 to about 2.5:1; and the image-receiving layer is coated in an amount of from about 10 gsm to about 60 gsm [claims 5 and 6]. The support is resin-coated paper or a transparent polymer film; and the image-receiving layer is cross-linked [see claims 7 and 8]. The image receiving layer contains a UV absorbing agent; and the pore volume of the image receiving layer is from 5-50ml/m<sup>2</sup> [see claims 9 and 10]. Yau '514 further teaches the presence of a base layer over the support [0035], but Yau '514 does not teach the base layer as recited in the claims.

25. However, Tang teaches an ink jet receiving medium comprising a base layer and a top layer, wherein the base layer comprises a crosslinked gelatin and a polyurethane dispersion (Table 5). The thickness of the base layer is 10um (col. 8, line 61). With respect to the swelling amount, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Tang reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article functions in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. With respect to the glass transition (Tg) value of the polyurethane dispersion, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected

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results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the Tg value in order to improve the flexibility of the layer (col. 4, line 47). A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215. To date, this burden has not been sustained. Furthermore, with respect to the particle size of the polyurethane dispersion, one of ordinary skill in the art would have been motivated to adjust the particle size in order to optimize coating durability and absorption property of the layer. Yau '514 and Tang are analogous art because they are from the same field of endeavor that is the ink jet recording medium art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the base layer of the Tang with the invention of Yau '514, and the motivation would be to reduce the curl and to absorb the majority of the ink (col. 6, line 5 of Tang).

### ***Response to Arguments***

26. Applicant's argument is based on that the Declaration under 37 CFR 1.131 serves to remove the Gallo reference as an effective publication through 35 USC 102(a). This argument is not persuasive because the Declaration under 37 CFR 1.131 is not acceptable for the following reasons: 1: An averment that the invention was made in the United States or in a NAFTA or WTO member country is missing; and 2: The Declaration was not executed by each of the inventors, it was executed by one of the inventors only.

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27. Applicant further argued that the "Statement of Common Ownership" serves to remove the Gallo reference as an effective publication through 35 USC 102(e). This argument is not persuasive because The Statement of Common Ownership is not adequate because Gallo was published before the US filing date of the current application, thus Gallo qualifies as prior art under subsection (a) of section 102. See MPEP 706.02(I)(3).

28. Applicant also argued that the Declaration under 37 CFR 1.132 serves to overcome the asserted inherency of Landry-Coltrain and Tang. This argument is not persuasive for the following reasons. In Experiment 1, the Applicant measured the swelling capacity of a different layer, i.e., one of the ink receiving layers. In [0167], the Control Element C-2 is one of the two ink receiving layers, not a base layer. The base layer that the Examiner referring to in the above rejection is in [0068], not in [0167]. In Experiment 2, the Applicant measured the swelling capacity of three base layers, and the Applicant used hydroxymethyl pyrrolidone, TCG-III class 30 gelatin and Witcobond W-213 polyurethane to form these layers. However, the hydroxymethyl pyrrolidone, the TCG-III class 30 gelatin and the Witcobond W-213 polyurethane are not the same as the ingredients that are used to form the base layers in Examples 11-13, they are not even the same as the ingredients that are used to form the base layers in any of the other Examples. Thus the Declaration under 37 CFR 1.132 does not provide evidence with respect to the claimed swelling capacity.

29. For the above reasons claims 1, 3, 5-9, 11, 13 and 15-24 stand rejected.



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***Conclusion***

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 7am-4:30pm.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald L. Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS

July 16, 2009.

/Betelhem Shewareged/

Primary Examiner, Art Unit 1794